

REMARKS

By this amendment, Applicants amend claims 1, 10, and 20, and cancel claim 5 without prejudice or disclaimer of the subject matter thereof. Claims 1-4, 6, 8-31, and 42-40 are now pending in this application of which claims 16-19, 27-31, and 42-46 have been withdrawn from consideration by the Examiner.

In the Final Office Action¹, the Examiner took the following actions:

rejected claims 1-6, 8, and 9 under 35 U.S.C. § 103(a) as being unpatentable over Haber (U.S. Re, 34,954) in view of Pasieka (U.S. Patent No. 6,587,945) and Falls (U.S. Patent No. 6,247,149);

rejected claims 10-13, 15, 20-23, 25, and 26 under 35 U.S.C. § 103(a) as being unpatentable over Haber in view of Pasieka, Falls, and Byrd (U.S. Patent No. 6,081,899); and

rejected claims 14 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Haber in view of Falls, Byrd, and X.509.

Applicants respectfully traverse the above rejections. A *prima facie* case of obviousness has not been established for at least the following reasons.

"The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. § 2142, 8th Ed., Rev. 7 (July 2008) (internal citation and inner quotation omitted). "[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the

¹ The Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Final Office Action.

prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). In rejecting a claim, “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Claim 1 recites a computer-implemented method for authenticating an electronic message sent from a sender to a recipient including, among other steps, “receiving, at an authentication server, the electronic message from the sender, the electronic message comprising message data and an electronic mail address of the recipient” and “sending the digest, the temporal stamp, the unique value, and the digital signature to the electronic mail address as an electronic postmark data structure.”

The Final Office Action alleges that “Haber teaches receiving the electronic message from a sender,” citing column 2, line 65 to column 3, line 10. Final Office Action at page 3. The Final Office Action further appears to allege that “sending to an electric address . . . such as an IP address, or email address” is inherent to the cited references. Id. at page 2. Both of these allegations are incorrect. Haber does not teach or suggest receiving, at an authentication server, an electronic message from a sender comprising message data and an electronic mail address of a recipient. Nor does Haber teach or suggest sending a digest, temporal stamp, unique value, and digital signature to the electronic mail address of the recipient as an electronic postmark data structure. Moreover, such elements are not inherent to the cited references, as discussed below.

Haber discloses:

In its general application as depicted in FIG. 1 of the drawing, the present method entails an author's preparation

of a digital document, which may broadly comprise any alphanumeric, audio, or pictorial presentation, and the transmission of the document, preferably in a condensed representative form, to the TSA. The TSA time-stamps the document by adding digital data signifying the current time, applying the agency's cryptographic signature scheme to the document, and transmitting the resulting document, now a certificate of the temporal existence of the original document, back to the author where it is held for later use in required proof of such existence.

Haber, col. 2, line 65 to col. 3, line 10 (emphases added).

As set forth above, Haber discloses that an author creates a document, which a time-stamping agency (TSA) time-stamps and then sends back to the author. That is, the author receives his or her own document back from the TSA. The “document” in Haber, therefore, does not constitute or suggest Applicants’ claimed “electronic message” which is sent from a sender to a recipient and includes an electronic mail address of the recipient. Accordingly, Haber does not teach or suggest “receiving, **at an authentication server, the electronic message** from the sender, the electronic message comprising message data and **an electronic mail address of the recipient**,” as recited in independent claim 1 (emphases added).

Moreover, since Haber does not teach or suggest receiving, at an authentication server, an electronic message comprising message data and an electronic mail address of a recipient, Haber cannot teach “sending the digest, the temporal stamp, the unique value, and the digital signature to **the electronic mail address [of the recipient]** as an electronic postmark data structure,” as further recited in independent claim 1. The Final Office Action contends that this element of the claim is met by Haber because the “document” in Haber is “transmitted to the author.” Final Office Action at page 3. However, this is not correct, as established above, because the document in Haber is

returned to the original author (i.e., the sender), but is not sent to an electronic mail address of a recipient, as claimed.

The other cited references, Falls, Pasieka, Byrd, and X.509, do not compensate for the deficiencies of Haber. That is, the other cited references also do not teach or suggest “receiving, at an authentication server, the electronic message from the sender, the electronic message comprising message data and an electronic mail address of the recipient” and “sending the digest, the temporal stamp, the unique value, and the digital signature to the electronic mail address as an electronic postmark data structure,” as recited in independent claim 1. Nor does the Final Office Action rely upon the other cited references for these elements.

Applicants further submit that the Final Office Action has not established that receiving an electronic message from a sender comprising an electronic mail address of a recipient or sending an electronic postmark data structure to the electronic mail address of the recipient is inherent to Haber or the other cited references. Specifically, “[t]o establish inherency, . . . extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.’” M.P.E.P. § 2112. However, “[t]he mere fact that a certain thing may result from a given set of circumstances is not sufficient” to establish inherency (emphasis added). Id. The Final Office Action alleges that “sending to an electric address . . . such as an IP address, or email address” is inherent, because “the transmission is sent electronically.” Id. at page 2. However, the Final Office Action has not provided any evidence that Haber or the other cited references necessarily transmits the claimed message, which includes an electronic

mail address of a recipient. Rather, for example, Haber merely discloses transmitting a document back to an author. See Haber, col. 2, line 65 to col. 3, line 10. Accordingly, the rejection of independent claim 1 is improper for at least this additional reason.

Moreover, even if the Final Office Action's allegations were correct, and an electronic mail address is inherent to the cited references, which Applicants do not concede, Applicants' claim 1 requires "receiving, at an authentication server, the electronic message from the sender, the **electronic message comprising message data and an electronic mail address of the recipient**" (emphasis added). That is, the electronic message comprises both message data and an electronic mail address of a recipient. As established above, Haber, which the Examiner relied upon for this claim element, discloses, at most, sending a document to its author, but does not disclose or suggest the claimed "electronic message," which includes an electronic mail address of a recipient.

Finally, Applicants note that independent claim 1 further recites "storing, **at the authentication server**, a copy of the digest, the temporal stamp, the unique value, and the digital signature in a log file" (emphasis added). Regarding this claim element, the Final Office Action proposes combining Haber with Pasieka and Falls, because Pasieka allegedly discloses "storing notarization information at the authentication server" and Falls allegedly discloses "creating a log with a digest." Final Office Action at page 3. However, Applicants submit that Haber teaches away from the proposed combination for at least the reason that the system in Haber, as established above, "transmit[s] the resulting document, now a certificate of the temporal existence of the original document, back to the author where it is held for later use in required proof of such existence"

(emphasis added). Haber, col. 3, lines 6-10. That is, in Haber, there is no reason to retain a "log file" at "an application server," as claimed, because the resulting document in Haber is itself sent back to the author and held by the author to prove that the document existed at the time of the time-stamp.

As explained above, the elements of independent claim 1 are neither taught nor suggested by the cited references, and the Final Office Action has cited no factors which would motivate one of ordinary skill in the art to modify the disclosures thereof to achieve the claimed combination. Consequently, the Final Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claim. Therefore, no reason has been clearly articulated as to why the claim would have been obvious to one of ordinary skill in view of the prior art and a *prima facie* case of obviousness has not been established for at least the above reasons.

Independent claims 10 and 20, while of a different scope from each other and claim 1, include recitations similar to those discussed above in connection with claim 1. Accordingly, for reasons similar to those discussed above, the cited references, individually or in combination, fail to teach or suggest all of the elements of claims 10 and 20. Accordingly, claims 10 and 20 are not obvious in view of the cited references for at least the reasons discussed above and the Examiner should withdraw the rejection of these claims under 35 U.S.C. § 103(a).

Claims 2-4, 6, 8, 9, 11-15, and 21-26 depend from one of independent claims 1, 10, and 20. Accordingly, claims 2-4, 6, 8, 9, 11-15, and 21-26 are not obvious in view of

the cited references at least due to their dependence. Therefore, the Examiner should also withdraw the rejection of these claims under 35 U.S.C. § 103(a).

CONCLUSION


In view of the foregoing, Applicants respectfully request reconsideration and reexamination of this application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: 

Anthony J. Lombardi
Reg. No. 53,232